REMARKS/ARGUMENTS

This paper is responsive to the Office Action dated April 11, 2008. Claims 1, 4 – 15, 18, 20 – 37, 39 – 44, 47, 49 – 61, 63 – 80, and 82 – 88 are pending. Claims 1 and 66 have been amended. Claims 89 and 90 been canceled without prejudice. No claims have been added. Withdrawal of the outstanding rejections to the pending claims is respectfully requested at least for the following reasons.

CLAIM AMENDMENTS

Claims 1 and 66 have been amended. These amendments have been made to expedite the prosecution of this matter, without limiting the scope of the invention, and only in an effort to impart precision to the claims (e.g., by more particularly pointing out the invention, rather than to avoid prior art). Additionally, the claim amendments are directed to original subject matter that the Examiner has already had the opportunity to examine and, as a result, these amendments do not necessitate a new prior art search by the Examiner. For example, claim 1 has been amended to correct antecedent basis on a claim feature. Dependent claim 66 has been amended to correct an error in the preamble of the claim. Specifically, please note that prior to amendment, claim 66 was directed to a "system." However, the base claim and any intervening claims for claim 66 are directed to methodologies. Accordingly, the preamble of claim 66 has been amended to change "[t]he system of […]" to "[t]he method of […]."

CLAIM REJECTIONS – 35 USC § 103

Claims 1, 5, 7, 18, 20, 22, 24 – 30, 40 – 44, 50, 59 – 61, 63, 65, 67 – 73, 83 – 86, 89, and 90 stand rejected under 35 USC §103(a) as being unpatentable over US Patent Number 6,853,461 to Shiimori ("Shiimori") in view of US Patent Number 6,980,964 to Cocotis et al. ("Cocotis"). This rejection is traversed. The Manual of Patent Examining Procedure (M.P.E.P.) states that, to support the rejection of a claim under 35 U.S.C. § 103(a), each feature of each rejected claim must be taught or suggested by the applied references, and that each of the words describing the feature must be taken into account.

> To establish prima facie obviousness of a claimed invention, **all** the claim limitations
> must be taught or suggested by the prior art. … **All** words in a claim **must** be

considered in judging the patentability of that claim against the prior art. (M.P.E.P. §
2143.03, emphasis added).

Each of the independent claims 1, 44, and 87 includes at least one feature not taught or
suggested by Shiimori or Cocotis, alone or in combination, and, therefore, is patentable for at least this
reason.

For example, independent **claim 1** recites:

- a computer readable medium embodying instructions for directing a first processing unit to:
  - Maintain a list of a plurality of fulfillment centers available to generate a photograph from said digital image,
  - Receive a request from a photographer processing unit for a list of options to generate said photographic product from said digital image,
  - Transmit to said photographer processing unit said list of options for generating said photographic product and a photographer list of a plurality of fulfillment centers that can fulfill said options,
  - Receive an order from said photographer processing unit, said order specifying at least one fulfillment center to fulfill the order,
  - Transmit routing information to said photographer processing unit wherein said routing information is for transmitting said digital image to a fulfillment center processing unit of one of said fulfillment centers to process said order,
  - Transmit said order to said fulfillment center processing unit of said one of said fulfillment centers; and
- a second computer readable medium embodying instructions for directing the photographer processing unit to: establish a connection with said first processing unit; receive said photographer list of fulfillment centers from said first processing unit; display said photographer list of fulfillment centers and the list of options for at least one of said fulfillment centers; after said list of options is displayed, receive an input specifying at least one fulfillment center to fulfill said order; transmit said image directly to said fulfillment center processing unit using said routing information; and transmit said order to said first processing unit.

The cited combination of references does not teach or suggest these claimed features.

Shiimori fails to teach or suggest "[r]eceive a request from a photographer processing unit for a list of options to generate said photographic product from said digital image" and "[t]ransmit to said photographer processing unit said list of options for generating said photographic product and a photographer list of a plurality of fulfillment centers that can fulfill said options," as claim 1 requires. The Office Action asserts that these claimed features are taught by Shiimori at Fig. 18, column 12, lines 14 – 24. Applicants disagree. Rather than teaching the claimed feature, the cited portion of Shiimori teaches that if a user and a client computer 1 make a certain selection (i.e., "Automatic"), a user can transmit personal registration information from the client computer 1 to the order-taking server 25. Shiimori describes at column 12, lines 25 – 40, that such transmitted personal information includes, for example, an address and zip code. Clearly, Shiimori's description that a client computer transmits address and zip code information for receipt by the order-taking server 25 does not teach, or fairly suggest, that the order-taking server 25 "receive[s] **a request** from a photographer processing unit **for a list of options to generate said photographic product from said digital imaging**" (emphasis added), as claim 1 requires. The teachings of Shiimori's Fig. 18 do not cure this deficiency.

Referring to Fig. 18 and the corresponding description of the figure at column 11, lines 8 – 23, Shiimori describes that a user sends information via client computer 1 to upload an image to the order-taking server, to create a postcard, or to create a calendar. Shiimori at column 11, lines 39 – 42, describes that "[w]hen a postcard creation service is selected by the user, postcard selection data indicating that the postcard creation service has been selected is transmitted from the client computer 1 to the order-taking server 25 (step 43). When the postcard selection data is received by the order-taking server 25, the available-server table (see Fig. 5) that has been stored on the hard disk of the order-taking server 25 is read out and the numbers of the stores providing the postcard service are retrieved (Search Results 1) (step 71). Data representing the Search Results 1 is transmitted from the order-taking server 25 to the client computer 1." Clearly, this explicit description of Shiimori does not teach, or fairly suggest, "[r]eceive a request from a photographer processing unit for a list of options to generate said photographic product from said digital image," and "[t]ransmit to said photographer processing unit said list of options for generating said photographic product and a photographer list of a plurality of

fulfillment centers that can fulfill said options," as claim 1 requires. Accordingly, and for this reason alone, Shiimori does not teach or suggest each and every element of claim 1.

The Office Action does not rely on Cocotis for the teaching of "[r]eceive a request from a photographer processing unit for a list of options to generate said photographic product from said digital image," and "[t]ransmit to said photographer processing unit said list of options for generating said photographic product and a photographer list of a plurality of fulfillment centers that can fulfill said options," as claim 1 requires. However, Applicants respectfully submit that Shiimori in view of Cocotis is also completely silent on this required feature of claim 1. Rather than teaching the claimed feature, Cocotis explicitly describes at column 7, lines 26 – 56, that a patron 401 (e.g., a photographer, etc.) utilizes webpages of interactive photo shop 402 to transfer payment information and a URL that identifies a digital image file stored in photo shop database 45 to market portal 403. Based on this information, the market portal 403 identifies and contacts a suitable photo service provider 404 to fill the order. The contacted photo service provider then utilizes the URL supplied by the interactive photo shop 402 to retrieve the image stored by the patron 401 in the photo shop database 45. Clearly, these descriptions of Cocotis are completely silent with respect to any teaching, or fair suggestion, of "[r]eceive a request from a photographer processing unit for a list of options to generate said photographic product from said digital image," and "[t]ransmit to said photographer processing unit said list of options for generating said photographic product and a photographer list of a plurality of fulfillment centers that can fulfill said options," as claim 1 requires.

Accordingly, and in view of the above, Shiimori alone or in combination with Cocotis fails to teach or suggest each and every element of claim 1. For this reason alone, claim 1 is not obvious over the cited combination of references.

Additionally, the Office Action admits that Shiimori does not teach or suggest "[t]ransmit routing information to said photographer processing unit wherein said routing information is for transmitting said digital image to a fulfillment center processing unit of one of said fulfillment centers to process said order," as claim 1 requires. Instead, the Office Action relies on the combination of Shiimori with Cocotis to assert that this claimed feature is obvious. Applicants disagree.

Claim 1 particularly points out and claims features associated with two (2) processing units – not three processing units. However, the Office Actions modification to Shiimori with the teachings of Cocotis at column 7, lines 45 – 56, requires operations from three (3) processing units (i.e., interactive photo shop 402, market portal 403, and photo service provider 404) to try to support its arguments. Specifically, claim 1 recites in part "**a first processing unit to** [m]aintain a list of a plurality of fulfillment centers [, r]eceive a request from **a photographer processing unit** [, t]ransmit to said photographer processing unit said list of options [, r]eceive an order **[, t]ransmit routing information** [, t]ransmit said order[.]" In contrast to these claimed features, Cocotis explicitly describes at column 7, lines 26 – 56, that a patron 401 (e.g., a photographer, etc.) utilizes webpages of **interactive photo shop 402** to transfer payment information and a URL that identifies a digital image file stored in photo shop database 45 to **market portal 403**. Based on this information, the market portal 403 identifies and contacts a suitable **photo service provider 404** to fill the order. The contacted **photo service provider 404 then utilizes the URL supplied by the interactive photo shop 402 to retrieve the image stored by the patron 401 in the photo shop database 45**. The Office Action asserts that the interactive photo shop 402 is the "photographer processing unit" of claim 1 (Office Action, page 2, section 2), and the market portal 403 represents the "first processing unit" of claim 1 (e.g., please see the Office Action, page 6, in reference to claims 7 and 50).

When asserting that the claimed feature of "the first processing unit [t]ransmit[s] the routing information to the photographer processing unit[,]", the Office Action does not show a teaching or suggestion that the entity previously mapped to the first processing unit (i.e., the market portal 403) transmits the routing information, but instead refers to **the third entity** associated with a third processing unit **(i.e., photo service provider 404)** to assert that transmitting the routing information from the first processing unit was obvious. Thus, in attempts to arrive at the features of claim 1, the Office Action requires operations from three (3) independent computing devices associated with three (3) independent processing units to try to support its arguments. Yet, claim 1 particularly points out and distinctly claims features associated with **only two (2) processing units** – not three (3) processing units. Clearly, operations of Cocotis that require a third processing unit independent of what the Office Action has already mapped to the claimed "first processing unit" does not teach or suggest the claimed features of "the first processing unit [t]ransmit[s] the routing information to the photographer

processing unit[,]" as claim 1 requires. Since **all the claim limitations must be taught or suggested** by the prior art to establish a prima facie case of obviousness, the cited combination of references does not teach, or fairly suggest, any computing device associated with the operations of the "first processing unit" sending routing information to the "photographer processing unit." Accordingly, and for this additional reason, Shiimori and/or Cocotis fail to teach each and every element of claim 1.

For at least each of the above reasons, withdrawal of the 35 USC §103 rejection of claim 1 over Shiimori and Cocotis is respectfully requested.

Although not identical, **independent claim 44** includes features that are also not taught or suggested by the cited combination of references for the reasons already discussed above with respect to claim 1. Withdrawal of the 35 USC §103 rejection of claim 44 is respectfully requested.

Claims 5, 7, 18, 20, 22, 24 – 30, 40 – 43, 50, 59 – 61, 63, 65, 67 – 73, and 83 – 86 are patentable at least for the reason that they depend on a patentable claim and include all its limitations.

Claims 4, 6, 8 – 14, 31 – 34, 47, 49, 51 – 57, and 74 – 77 stand rejected under 35 USC 103(a) as being unpatentable over Shiimori and Cocotis as applied to claims 1, 7, 29, 30, 44, 50, 72, and 73 above, and further in view of allegedly well-known prior art. This rejection is respectfully traversed. All of these claims depend on a patentable claim and, therefore, are patentable. In addition, all of the rejections are seemingly based on the Examiner's personal knowledge and opinion of what is well-known art, not references. While these limitations may be known in art somewhat distant from the photographic software art, no evidence is provided that the specific applications of the limitations and motivations for supplying these limitations are known in the art of the invention. *Ex Parte Nouel,* 158 USPQ 237, 239 (POBA 1967) at headnote 2.

According to 37 CFR §1.104(d)(2), "[w]hen a rejection in an application is based on facts within the personal knowledge of an employee of the office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons." If this rejection of claims 4, 6, 8 – 14, 31 – 34, 47, 49, 51 – 57, and 74 – 77 is

maintained on a similar basis in a subsequent Office Action, the Examiner respectfully is requested to supply such an affidavit subject to contradiction or explanation by the affidavits of the Applicants and other persons to support these otherwise unsupported modifications to Shiimori and Cocotis.

Claims 15, 21, 58, 64, 87, and 88 stand rejected under 35 USC 103(a) as being unpatentable over Shiimori and Cocotis as applied to claims 1, 20, 44, and 63 above, and further in view of Arledge, Jr., et al. (US Patent No. 6,535,294, hereinafter "Arledge"). This rejection is respectfully traversed. It is not seen how Arledge is related to the present invention. First of all, the portion of Arledge referred to by the Examiner, namely FIG. 7 and column 14, lines 16 – 31, does not disclose a web page with pointers to web pages listing options, but rather web pages listing products, such as t-shirts, mugs, posters, etc. See FIG. 7 and column 7, lines 29 – 34. Thus, Arledge does not provide the flexibility of the present system in which the options for printing the image can be specified. Further, Arledge presents to the end user fulfillment centers based on the state and country selected by the user. This teaches against the present invention in which the list of fulfillment centers has no relation to the state and country specified by the end user, but rather is related only to the options available at the fulfillment center. Further, once an end user selects a fulfillment center, it is fixed and does not change. This is done to enhance end user loyalty. Once again, the idea is to control the end user. The end user cannot select a fulfillment center to fulfill a specific order. Nor can the end user select a fulfillment center based on the options available at the fulfillment center. In sum, Arledge does not provide what is missing in Shiimori and Cocotis. Thus, claims are patentable over the combination of Shiimori, Cocotis, and Arledge.

Claims 23, 35 – 37, 39, 66, 78 – 80, and 82 have been rejected under 35 USC 103(a) as being unpatentable over Shiimori and Cocotis as applied to claims 29, 60, and 72 above, and further in view of Garfinkle et al. (US Patent No. 6,017,157, hereinafter "Garfinkle"). This rejection is respectfully traversed. Garfield is relied on for the teaching of an order that includes a graphic instruction set for a photograph. Even assuming arguendo that Garfield supplies such a teaching, this teaching in combination with Shiimori and Cocotis does not cure the deficiencies described above with respect to this primary and secondary reference combination. Accordingly, all of these claims depend on a

patentable claim and, therefore, are patentable. *In re Fine*, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) at headnote 4.

      In view of the above amendments and remarks, Applicants believe the pending application is in condition for allowance. Applicants believe no additional fee is due with this response. However, if any additional fee is due, please charge our Deposit Account No. 50-1848, under Order No. 010684.0103PTUS from which the undersigned is authorized to draw.

Respectfully submitted,
PATTON BOGGS LLP

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By: ___/Brian G. Hart/_____
Brian G. Hart
Registration No.: 44,421
(303) 830-1776
(303) 894-9239 (Fax)
Customer No. 24283   Attorney for Applicants